In the previous action, claims 1-4 were amended into method claims. However, the Final Office Action maintained the anticipation rejections over JP 10158336 or U.S. 4,219,632 ("Simms"), U.S. 4,608,314 ("Turpin et al.") and U.S. 4,533,681 ("Cassatta et al.") or EP 610534.

In particular, the Final Office Action alleged that amending the composition claims into method claims failed to impart patentability onto the new method claims because discovery of an old structure based on unknown properties only "might" be patentable. The Final Office Action further alleged that the presently pending claims do not result in a structurally different composition from that of the prior art and that the prior art structure is capable of performing the intended use.

Based on these assertions, it appears that the Final Office Action may have confused the meaning of the rule regarding the patentability of new uses of old compounds. While the Final Office Action is entirely correct that the discovery of new properties of old compositions does not impart patentability onto the old compositions themselves, Applicants note that they are **not** claiming the compositions but rather a method of using the compositions for preventing a whitening phenomenon for solvent-borne paints.

Regarding the Final Office Action's citation to MPEP 2112.02,

Applicants note that the Final Office Action appears to mis-read the section insofar as In Re May very clearly supports Applicants position that new and unobvious methods are patentable. For example, the middle portion of the paragraph of MPEP 2112.02 clearly states:

> The [May] court went on to **reverse** the [Examiner's] rejection of claims 2-5 and 7-10 which recited a process of using a new compound.

Furthermore, In re May, 197 USPQ 601, 607 (CCPA 1978) states:

> Balancing the *prima facie* case of obviousness made out by the PTO against appellants' objective evidence of nonobviousness, we hold that the subject matter of appealed claims 2-5 and 7-10 would **not** have been obvious to one of ordinary skill in the art.

Applicants note that claims 2-5 and 7-10 as appealed in In re May recite method claims.

Given the above, Applicants request the Examiner to reconsider her position regarding the patentability of the presently pending method claims, which were amended into such form to overcome the previous rejections.

Accordingly, Applicants respectfully request the Examiner to enter the amendment to claim 1 and reconsider and allow all claims pending in this application in view of the remarks.

CONCLUSION

In light of the foregoing, Applicants submit that the application is now in condition for allowance. The Examiner is therefore respectfully requested to reconsider and withdraw the rejection of the pending claims and allow the pending claims. Favorable action with an early allowance of the claims pending is earnestly solicited.

Respectfully submitted,

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BOX AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	Group Art Unit: 1714
UEHARA; YAMAZAKI; OHIRA; KAWAHITO	)	Examiner: Callie E. Shosho
Serial No. 09/925,451	)	
Filed: August 10, 2001	)	

For: **ADDITIVES FOR PAINTS AND INKS**

Appendix A

Please amend the claims according to the proposed revision to 37 C.F.R. § 1.121 concerning a manner for making claim amendments.

1. (Currently amended) A method for preventing a whitening phenomenon for solvent-borne paints, which is characterized by ~~comprising~~ adding to the solvent-borne paints a copolymer of 2-50% by weight of a reactive monomer having isocyanate group or an isocyanate-derived group with 98-50% by weight of other monomer or polymer which is reactable with said reactive monomer.

2. (Previously amended) The method of Claim 1, in which the reactive monomer having isocyanate group is 2-isocyanatoethyl methacrylate, 2-iso-cyanatoethyl acrylate or 3-isopropenyl-α,α-dimethylbenzyl isocyanate.

3. (Previously amended) The method of Claim 1, in which the reactive monomer having a group derived from isocyanate groups is 2-(O-[1'-methyl-propylideneamino]carboxyamino)ethyl methacrylate, or 2-(O-[1'-methylpropylideneamino]carboxyamino)ethyl acrylate.

4. (Previously amended) The method of Claim 1, in which the monomer or polymer reactable with said reactive monomer having isocyanate group or an isocyanate-derived group is an alkyl ester of acrylic acid, alkyl ester of methacrylic acid, alkyl vinyl ether, reactive silicone having methacryloyloxy group, reactive acrylic polymer or butadiene polymer.